



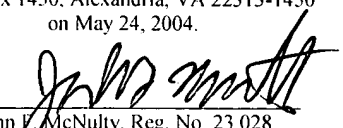
1761 #
JFW

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/051,511
Filed: January 18, 2002
Inventor: Richard M. Palmer et al.
For: Candy Package
Examiner: Steven L. Weinstein
Art Unit: 1761
Atty. Doc. No.: 341-01

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Post Office as first class mail postage prepaid in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 24, 2004.


John F. McNulty, Reg. No. 23,028
Dated: May 24, 2004

COVER LETTER WITH CERTIFICATE OF MAILING

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

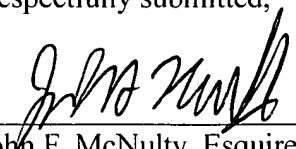
Enclosed and attached hereto are the following documents:

- (1) Cover Letter with Certificate of Mailing (1 pg.);
- (2) Petition for one-month extension of time (1 pg.);
- (3) Response to Office Action (5 pgs.);
- (4) Check in the amount of \$110.00; and
- (5) Paul & Paul Postcard to be returned by the PTO.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES ASSOCIATED WITH THIS COMMUNICATION, OR CREDIT ANY OVERPAYMENT, TO PAUL & PAUL DEPOSIT ACCOUNT NO. 16-0750,

Respectfully submitted,

Date: May 24, 2004


John F. McNulty, Esquire
Reg. No. 23,028
Paul & Paul
2900 Two Thousand Market St.
Philadelphia, PA 19103
(215) 568-4900

Order No. 2295



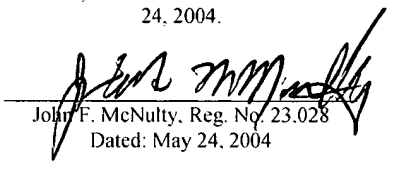
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Dated: May 24, 2004

RESPONSE TO OFFICIAL ACTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the official action of January 27, 2004, a petition for a one-month extension of time being filed concurrently herewith.

The rejection of January 27, 2004 is a most extraordinary rejection.

The examiner makes the rejection over a combination of **12** references.

In doing so, the examiner defies over 52 years of patent law starting at least as early as the statutory test of "obviousness" under the 1952 Patent Act, and defies virtually every decision of the Court of Appeals for the Federal Circuit, all of which absolutely require that any "obviousness" rejection that is based on a combination of references

must include a pointing out by the examiner, **specifically** wherein which item of prior art reference there is a teaching for combining it with a second prior art reference.

Here there are no such teachings provided by the examiner for any combination of any two references; any certainly none are provided teaching combinations of 12 references.

Additionally, the examiner defies every requirement of the Federal Circuit that an applicant's disclosure cannot be used as a hindsight teaching for combining references.

In *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the Court stated:

In this case, the Board fell into the hindsight trap.

There, the Court went on to state:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

In making the rejection in this case, **nowhere** does the examiner point to any teaching of making a combination. In fact, no "teaching" whatever is mentioned in the entire official action.

In *In re Dembiczak*, the Court condemned the use of the inventor's disclosure as a blueprint for piecing together the prior art:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.

In that case, the Court was dealing only with a proposed combination of 3 references or 4 references; not 12 references, as here.

In *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), the Court admonished that, even if a combination of references (3 in that case) contains all of the elements of an applicant's claims, it is reversible error to determine that one of skill in that art would have been motivated to combine those references in a manner that rendered the claimed invention obvious, unless in making the rejection, one can point to some motivation from those references to choose the references and make the combination:

Therefore, the Board did not err in finding that the combination of King, Rosen, and Ruddy contains all of the elements claimed in Rouffet's application.

However, the Board reversibly erred in determining that one of skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention obvious. Indeed, the Board did not identify any motivation to choose these references for combination.

In that case the missing "teachings to combine" were omitted from a rejection based on 3 references; in the instant case, they are absent from a rejection based upon a combination of 12 references!

And in *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), the Court again noted that the Board impermissibly used hindsight to arrive at the claimed invention, stating:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

In that case, there were only 2 pieces of prior art combined without any teachings; not 12, as here.

And in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the Court held that an invention **cannot** be held to have been obvious unless something **specific** in a prior art reference provides the teaching:

...there must be some teaching, reason, suggestion, or motivation found “in the prior art” or “in the prior art references” to make a combination to render an invention obvious within the meaning of 35 U.S.C. § 103 (1988). Similar language appears in a number of opinions and if taken literally would mean that an invention cannot be held to have been obvious unless something specific in a prior art reference would lead an inventor to combine the teachings therein with another piece of prior art.

In that case the Court was dealing only with two patents that were combined without teachings to combine them; not 12, as here.

Again, in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), the Court reiterated that obviousness **cannot** be established by combinations of prior art unless there is a specific teaching:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined **only** if there is some suggestion or incentive to do so...The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In that case, again, the Court was dealing only with 2 patents that were combined without a teaching for doing so; not 12.

In *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989), the Court condemned a retrospective view of inherency:

...A retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination.

In that case, again, the Court was dealing only with a combination of 3 references devoid of some teaching advanced by the Patent Office for combining them; not 12, as here.

In *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), the Court again condemned the making of combinations based upon conclusions, without offering support or explanation for where in specific prior art there are teachings for making the combination:

The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.

There again, the Court was dealing only with combinations of 2 and 3 references without support in the rejection for where the teaching was for making the combination; not 12.


If anything is clear on this record, it is that the law has **not** been applied; the art contains no teachings for making the combinations that the Examiner has made, and the Examiner does not even attempt to offer any specific teachings.

That somewhere in the mass of prior art, some dealing with candy packages, others not, that most, many or even all of the features recited in the claims might somewhere be contained, does *not* make a case for obviousness, and none can be made in this instance. An aggregation of features that are somehow present along with many, many others, in 12 references, has nothing to do with the obviousness or unobviousness of combining 1, 2 or 3 references, let alone 12.

Withdraw of the rejection and allowance of all the claims is respectfully solicited.

Respectfully submitted,

Date: May 24, 2004


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